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09/428,387	10/28/1999	ADAM MICHAEL FENNE	17954-15	4586

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EXAMINER

VU, NGOC K

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 07/08/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/428,387

Applicant(s)

FENNE, ADAM MICHAEL

Examiner

Ngoc K. Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,5-23,25-31,33,34,36-40 and 42-50 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1,5,9-23,25-31,33,34,36-40 and 42-50 is/are rejected.

- 7) ☐ Claim(s) 6-8 is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 5-23, 25-31, 33, 34, 36-40 and 42-50 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-22, 34, 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first viewer viewing behavior information" in line 10, "the second viewer viewing behavior information" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the first viewer demographic information and the first viewer second viewing behavior information " in lines 7-8. There is insufficient antecedent basis for this limitation in the claim.

Claim 34 recites the limitation "the first-viewer viewing information" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 37 recites the limitation "the first viewer information" in line 4, "the second-viewer information" in line 10. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 5, 9, 10, 12, 14-20, 22, 23, 26-28, 31, 33, 34 and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al (US 6,463,585 B1).

Regarding claim 1, Hendricks discloses a message delivery method, comprising:

- (a) delivering viewing behavior information of a first viewer from one or more viewing stations which the first viewer is using to a processing system (providing the network controller 214 or the operation center 202 a particular viewer access history and viewing habits);
- (b) delivering demographic information regarding the first viewer to the processing system (proving the network controller 214 or the operation center 202 a particular viewer demographic information);
- (c) delivering viewing behavior information of a second viewer from one or more viewing stations which the second viewer is using to the processing system (providing the network controller 214 or the operation center 202 a particular viewer access history and viewing habits);
- (d) delivering demographic information regarding the second viewer to the processing system (proving the network controller 214 or the operation center 202 a particular viewer demographic information);

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(e) processing the first viewer viewing behavior information and demographic information regarding the first viewer delivered to the processing system to select a first viewer multimedia message targeted to the first viewer (generating the advertisements towards particular viewers and makes use of a viewer's demographic information and viewing habits to determine the advertisement that are of most interest to that particular viewer);

(f) processing the second viewer viewing behavior information and demographic information regarding the second viewer delivered to the processing system to select a second viewer multimedia message targeted to the second viewer generating the advertisements towards particular viewers and makes use of a viewer's demographic information and viewing habits to determine the advertisement that are of most interest to that particular viewer. It is noted that the advertisements targeted towards individual viewer or groups of viewers); and

(g) delivering the first viewer multimedia message to a viewing station of the first viewer (delivering the targeted advertisement to the particular viewer) (see col. 63, lines 57-63; col. 66, lines 16-66; col. 67, lines 1-4; col. 68, lines 48-55; col. 72, lines 46-51; col. 74, lines 62-67).

Regarding claim 23, Hendricks discloses a message delivery system, comprising:  
a processing system (the network controller 214 or the operation center 202);  
means for delivering to the processing system viewing information on the viewing of multimedia content by a first viewer (providing the network controller 214 or the operation center 202 a particular viewer access history and viewing habits);  
means for displaying at a viewing station multimedia content for viewing by the first viewer (displaying the local programming or television programming);  
wherein the processing system uses the viewing information to select a desired sponsored video message (selecting the targeted advertisement based on the particular viewer access history and viewing habits);

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means for delivering demographic information about the first viewer to the processing system (providing the network controller 214 or the operation center 202 the particular viewer demographic information);

wherein the processing system also uses the demographic information to select the desired message (selecting the targeted advertisement based on the particular viewer demographic information);

and means for delivering the message to a viewing station for viewing by the first viewer in conjunction with the viewing by the first viewer of the multimedia content (delivering the targeted advertisement with local programming to the particular viewer) (see col. 61, lines 30-42; col. 63, lines 57-63; col. 66, lines 16-66; col. 67, lines 1-4; col. 68, lines 48-55; col. 72, lines 46-51; col. 74, lines 62-67).

Regarding claim 31, Hendricks discloses a message delivery system, comprising:

- first and second viewing stations (more than one set top terminals);
- a multimedia content server (202);
- a message server (202) including a plurality of different sponsored video messages;
- a processing server (214 or 202) which processes multimedia viewing information about a first viewer and therefrom selects a first message from the plurality of messages (providing the network controller 214 a particular viewer access history and viewing habits);
- wherein the processing server also processes demographic information of the first viewer to select the first message (providing the network controller 214 or the operation center 202 the particular viewer demographic information);
- the first station presenting the first message from the message server and multimedia content from the multimedia content server for viewing by the first viewer (providing the particular viewer the local programming or television programming and the targeted advertisement);

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the processing server processing multimedia viewing information about a second viewer and therefrom selecting a second message from the plurality of messages (providing the network controller 214 a particular viewer access history and viewing habits);

wherein the processing server also processes demographic information of the second viewer to select the second message (providing the network controller 214 or the operation center 202 the particular viewer demographic information);

and the second station presenting the second message from the message server and multimedia content from the multimedia content server for viewing by the second server (providing the particular viewer the local programming or television programming and the targeted advertisement) (see col. 11, lines 8-12; col. 62, lines 24—30; col. 56, lines 50-59; col. 63, lines 15-20, 57-61; col. 67, lines 3-4; col. 68, lines 48-55).

Regarding claim 34, Hendricks discloses a processing server programmed to:  
receive multimedia first-viewer viewing information and first-viewer demographic information relative to a first-viewer (receiving a particular viewer access history/viewing habits and demographic information);  
process the first-viewer viewing information and first-viewer demographic information to obtain first processed information, and associate the first processed information with a first sponsored video message from a database of messages for delivery to a first viewing station for viewing by the first-viewer together with multimedia (providing the particular viewer the local programming or television programming with the targeted advertisement based on the viewer access history/viewing habits and demographic information);  
receive second-viewer multimedia viewing information and second-viewer

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demographic information relative to a second viewer (receiving a particular viewer access history/viewing habits and demographic information); and  
process the second-viewer viewing information and second-viewer demographic information to obtain second processed information and associate the second processed information with a second sponsored video message from the database for delivery to a second viewing station for viewing by the second-viewer together with multimedia (providing the particular viewer the local programming or television programming with the targeted advertisement based on the viewer access history/viewing habits and demographic information) (see col. 61, lines 30-42; col. 63, lines 57-63; col. 66, lines 16-66; col. 67, lines 1-4; col. 68, lines 48-55; col. 72, lines 46-51; col. 74, lines 62-67).

Regarding claim 37, Hendricks discloses a processing server, comprising:  
means for receiving first-viewer demographic information and first viewer multimedia viewing information, both relative to a first viewer (receiving a particular viewer access history/viewing habits and demographic information);  
means for processing the first-viewer informations to obtain a first signal for delivery to a message server for selecting therefrom a desired first sponsored video message, the first message to be viewed by the first viewer at a viewing station (providing the particular viewer the local programming or television programming with the targeted advertisement based on the viewer access history/viewing habits and demographic information);  
means for receiving second-viewer demographic information and second-viewer multimedia viewing information, both relative to a second viewer (receiving a particular viewer access history/viewing habits and demographic information); and  
means for processing the second-viewer informations to obtain a second signal for delivery to the message server for selecting therefrom a desired second sponsored video message, the

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second message to be viewed by the second viewer at a viewing station (providing the particular viewer the local programming or television programming with the targeted advertisement based on the viewer access history/viewing habits and demographic information) (see col. 61, lines 30-42; col. 63, lines 57-63; col. 66, lines 16-66; col. 67, lines 1-4; col. 68, lines 48-55; col. 72, lines 46-51; col. 74, lines 62-67).

Regarding claim 5, Hendricks discloses the processing of (e) and (f) are at the processing system (see col. 56, lines 48-52).

Regarding claim 9, Hendricks discloses delivering the second viewer multimedia message to a viewing station of the second viewer (see col. 67, lines 1-4; col. 70, lines 34-39).

Regarding claim 10, Hendricks discloses delivering the message with multimedia content to the viewing station of the first viewer (see col. 61, lines 38-44).

Regarding claim 12, Hendricks discloses the viewing station including a television (see col. 10, lines 1-2; col. 14, lines 49-52).

Regarding claim 14, Hendricks discloses the processing system includes a processing server operatively connected to the Internet (see col. 59, lines 11-14).

Regarding claim 15, Hendricks discloses the first multimedia message is a video message (see col. 70, lines 1-4).

Regarding claims 16-18, Hendricks discloses the viewing behavior is video viewing behavior, wherein the viewing behavior information including the time of viewing by the first viewer, the length of viewing time of the first viewer at the viewing station (see col. 66, lines 46-49, 64-66; col. 69, lines 65-67).

Regarding claim 19, Hendricks discloses includes presenting the first viewer multimedia messages when there is a break in the availability of the multimedia content for presentation at the viewing station (see col. 27, lines 39-47).

Regarding claim 20, Hendricks discloses delivering the first viewer multimedia message to the viewing station simultaneously with the delivers of the multimedia content thereto (see col. 61, lines 30-44).

Regarding claim 22, Hendricks discloses that the cable TV systems with a more limited bandwidth are able to use the program delivery system 200 by only accepting the number of parts that the cable system can handle within its bandwidth (see col. 52, lines 34-37).

Regarding claim 26, Hendricks discloses the displaying means includes the viewing station including a computer monitor and a computer speaker (see col. 65, lines 12-14).

Regarding claim 27, Hendricks discloses the displaying means includes the viewing station including a television (see col. 10, lines 1-2; col. 14, lines 49-52).

Regarding claim 28, Hendricks discloses the viewing information includes viewing information on the first viewer every time the first viewer logs onto the processing system and views multimedia content (see col. 63, lines 59-61; col. 65, lines 10-13; col. 66, lines 46-49).

Regarding claim 33, Hendricks discloses a recipient assembly which presents viewer/viewing information transmitted thereto by the processing server (see col. 15, lines 14-17, 24-27).

Regarding claim 36, Hendricks disclose the server further programmed to transmit viewer/viewing information to a recipient assembly for presentation to a recipient (see col. 14, lines 47-52).

Regarding claim 38, Hendricks discloses delivering viewer/viewing information to a recipient assembly for presentation to a recipient (see col. 14, lines 47-52).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13, 21, 29, 30, 39, 40 and 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al (US 6,463,585 B1).

Regarding claim 13, Hendricks does the viewing station is television system (see abstract) but not specifically disclose the viewing station including a video-on-demand. Official Notice is taken that the television system including a video-on-demand service is well known in the art. It would have been obvious to one of ordinary skill in the art to modify Hendricks by including a video on demand service for providing the requested video to a particular viewer to enhance the television system.

Regarding claims 21, 29 and 30, Hendricks providing the advertisement to the set top box; for instance, the network controller transmits data which informs the set top terminal which of the multiple commercial channels is assigned to a television program category (see col. 72, lines 25-28). Hendricks does not disclose pre-caching the first viewer multimedia message for at the viewing station when multimedia content to be viewed is generally not available for presentation. Official Notice is taken that pre-caching data is commonly used in the industry. It would have been obvious to one of ordinary skill in the art to modify Hendricks by including pre-caching to optimize data transfer by pre-downloading a local copy of data accessed over a network to a specialized local buffer storage that is continually updated.

Regarding claim 44, Hendricks discloses a presentation delivery method, comprising:  
(a) providing a sponsored message to a viewing station (providing the advertisement to the set top box; for instance, the network controller transmits data which informs the set top terminal which of the multiple commercial channels is assigned to a television program category);

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(b) loading at least a portion of multimedia content at the viewing station (loading the local programming or television programming);

(c) during (b), presenting the sponsored message at the viewing station to a viewer (presenting the advertisement during program break timing);

(d) after (c), presenting the multimedia content at the viewing station to the viewer (returning the local programming or television programming after the advertisement) (see col. 72, lines 25-28; col. 27, lines 39-45; col. 28, lines 9-16). Hendricks does not disclose pre-caching the sponsored message at the viewing station. Official Notice is taken that pre-caching data is commonly used in the industry. It would have been obvious to one of ordinary skill in the art to modify Hendricks by including pre-caching to optimize data transfer by pre-downloading a local copy of data accessed over a network to a specialized local buffer storage that is continually updated.

Regarding claims 45-47, Hendricks discloses obtaining information relative to the viewer and based on the information, selecting the message so as to be specifically targeted to that viewer; wherein the information includes prior multimedia viewing information of the viewer, the information further includes demographic information on the viewer (see col. 68, lines 48-55; col. 69, lines 62-67).

Regarding claim 48, Hendricks discloses the sponsored message is a video message (see col. 70, lines 1-4).

Regarding claims 39 and 40, Hendricks discloses a presentation delivery method, comprising: delivering a sponsored message to a viewing station (delivering an advertisement to a viewer); delivering multimedia content to the viewing station (delivering the local programming or television programming); presenting the delivered multimedia content at the viewing station

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(presenting the advertisement at the set top terminal) (see col. 61, lines 30-48; col. 62, lines 24-27; col. 72, lines 25-28; col. 74, lines 61-67).

Hendricks discloses that the set top terminal provide access to web sites and data bases on the Internet, and also provide communications with the cable headend 208 and the operations center 202 (see col. 65, lines 10-14). Hendricks does not discloses delivering the sponsored message and multimedia content over the Internet to the viewing station. Official Notice is taken that transmitting the advertisement and video programming over the Internet to the viewer is well known in the art. It would have been obvious to one of ordinary skill in the art to modify Hendricks by delivering the advertisement and video programming over the Internet to the viewer in order to visually introduce the product or service while displaying the video programming to the viewer via web browser.

Further regarding claim 39 and 42, Hendricks providing the advertisement to the set top box; for instance, the network controller transmits data which informs the set top terminal which of the multiple commercial channels is assigned to a television program category (see col. 72, lines 25-28). Hendricks does not disclose pre-caching the first viewer multimedia message for at the viewing station when multimedia content to be viewed is generally not available for presentation. Official Notice is taken that pre-caching data is commonly used in the industry. It would have been obvious to one of ordinary skill in the art to modify Hendricks by including pre-caching to optimize data transfer by pre-downloading a local copy of data accessed over a network to a specialized local buffer storage that is continually updated.

Regarding claim 43, Hendricks discloses the multimedia content is not available because (c) includes a break in the delivering of the multimedia content (see col. 27, lines 39-45).

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***Allowable Subject Matter***

8. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gupta et al (US 6,487,538 B1) teaches a method and apparatus for local advertising.


Cremia (US 6,477,704 B1) teaches a method of gathering and utilizing demographic information from request-based media delivery system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

NV  
June 30, 2003

  
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